IN THE

Supreme Court of the United States

OCTOBER TERM, 1950.

No. 274

AUTOGRAPHIC REGISTER COMPANY,

Petitioner,

vs.

UARCO INCORPORATED,

Respondent.

BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI.

To the Honorable Chief Justice and the Associate Justices of the Supreme Court of the United States:

OPINIONS BELOW.

The decision of the District Court (R. 602) holding all of the patents in suit were invalid for lack of patentable invention is reported in 86 F. Supp. 730; and the opinion of the Court of Appeals for the Seventh Circuit (R. 954), affirming the judgment and finding the patents invalid for want of patentable invention over the prior art is reported in 182 F. 2d. 353. There are no conflicting decisions, and no decision sustaining any of the patents.

JURISDICTION.

The jurisdictional requisites are adequately presented in the petition.

QUESTIONS PRESENTED.

Petitioner has propounded three questions that do not properly arise under the facts appearing in the record. The questions concern the right of the Court of Appeals to "properly and legally" hold the patents invalid for lack of patentable invention.

1. The first question is bottomed on alleged commercial success, but Plaintiff's proposed exhibits to indicate commerial success were not admitted in evidence (R. 168-171) and petitioner did not urge or point out any errors in the ruling.

2. The second question assumes that the patents were held invalid merely because the devices are simple in construction. The Court of Appeals did not mention the simplicity of the structures. The patents were held to lack invention over the prior art discussed in the opinion.

3. The last question concerns whether the Greig patent was a proper reference because it was amended during its prosecution. The teachings of this patent, relied upon as an anticipation, were in the Greig application as originally filed, and that date of filing was admittedly long prior to the alleged invention of Johnson.

STATEMENT OF THE CASE.

In the District Court, petitioner sued on four patents, but after all four were held invalid for lack of invention it appealed on only three. None of the patents discloses any invention, but each claims the most trivial variations in continuous-form stationery which were made by various

competitors as soon as the need arose. When continuous-form stationery became popular in the middle twenties, due to the increasing cost of office help, a flood of patents resulted.

Respondent developed its accused stationery and marketed it long before it knew of petitioner's work or attempt to obtain the patents in suit. Petitioner kept all of the patents pending in the Patent Office, from nine years and nine months for the first Brenn patent to twelve years and eight months for the Johnson patent. During this period respondent's stationery, and that of other competitors, was being popularized and going into wide use.

BRENN PATENT 2,082,730 (R. 630).

Petitioner found that it could avoid infringement of Brown patent (R. 766), which claimed separate strips of stationery, by stapling the strips together. It then obtained the patent in suit by specifying that the staple was on the line of weakening. As pointed out in the decision of the Court of Appeals, the prior art shows that it was old to staple strips together on the line of weakening between forms. The Court concluded that Brenn "did no more than might be expected of one skilled in his calling."

JOHNSON PATENT 2,258,573 (R. 636).

The structure of the Johnson patent was admittedly devised to avoid the notched corner construction shown in Bottle Patent 1,736,427. The prior art shows that it was old to insert sheets of paper in a typewriter with the carbon sheets offset so as to facilitate their separation after typing is completed. Johnson did the same thing in continuous-form stationery. The Court of Appeals pointed out that Bottle and others had suggested various means to facilitate ease of separation. The Court said (R. 959)

> "With this evidence before us, supplemented by the testimony of witnesses, the District Court found that Johnson had not achieved invention. We think the record is such that we are without right to set aside this finding. Rather, we agree that Johnson, working in a crowded art, merely adopted the expedient of one skilled in the calling of assembling and disassembling multiple sheets consisting of work sheets and carbon sheets. * * * We think that the adoption of any one of these methods was the choice of the worker and did not arise to the dignity of patentable invention."

That the conclusion of both of the lower courts is correct is further supportedby the record which shows that fourteen other people, independently, confronted with the same problem, solved it at about the same time, as soon as the need appeared. It is difficult to imagine more compelling evidence that the Johnson structure was obvious to those skilled in the art. In view of the findings, the Court did not find it necessary to pass on the further defense that the Johnson patent application was broadened during its prosecution to cover subsequent developments of others.

BRENN PATENT 2,212,174 (R. 930).

This patent discloses and the claims in suit specify that the work sheet strips are provided at one of the lateral edges with a feeding band. The patent makes it clear that the "feeding band" has regularly spaced holes so that the stationery may be fed around the platen of a typewriter by means of a pin wheel. The accused stationery does not have a feeding band.

Phillips and Allen Patent 2,306,900 (R. 940) shows continuous-form stationery secured to a carrier belt provided with feed holes. In Fig. 2, the "feeding bands" are detachable along a line of weakening. Brenn lost an interference

with these inventors, (Defendant's Exhibit D-16, pages 32, 48).

Phillips and Allen 2,149,544 (R. 916) shows continuous-form stationery with interleaved carbon held by a lateral binding strip, and Brown Patent 1,738,863 (R. 786) shows continuous-form stationery attached at one side by a detachable binding strip similar to respondent's.

Brenn also lost an interference with Stevens, (Defendant's Exhibit D-16, page 46) but Brenn then obtained a patent by claiming Stevens' sets in continuous strips.

The Court of Appeals concluded that Brenn, working in a crowded field, made the kind of a suggestion that would occur to any typist who took the time to think about the problem. The Court said,

> "At any rate, the evidence is such, consisting not only of documentary evidence but also of parol testimony, that we conclude that we would be wholly unjustified in setting aside the finding of invalidity."

FINDINGS OF NO INVENTION.

Both the Court of Appeals and the District Court made a careful examination of the patents in suit with the prior art and found that no patentable invention was involved. The District Court considered various interrogatories and answers, heard considerable testimony by experts in open court, and examined the voluminous file wrapper of the Johnson patent and commented on it at length. The District Court said:

> "I believe, and therefore find as a fact, that none of the alleged patents in suit are inventions, but at the most improvements in technique or mechanical skill and are, therefore, void.

The Court of Appeals in its decision, after discussing the patents in suit and much of the pertinent art, concluded:

> "After consideration of the entire record we are of the opinion that all three of these patents reflect not patentable invention but merely the exercise of the skill of the calling and an advancement plainly in accord with the prior art, within the decision of the Supreme Court in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 62 S. Ct. 37, 39, 86 L. Ed. 58".

This Court said in *The Goodyear Tire & Rubber Company, Inc., and General Dry Batteries, Inc.* v. *Ray-O-Vac Company,* 321 U. S. 276:

> "It must be a strong case in which this Court will set aside these concurring findings of two courts."

See also *Williams Mfg. Co.* v. *United Shoe Machinery Co.*, 316 U. S. 364, 367.

CONCLUSION.

As petitioner has failed to point out any manifest error which should cause this Court to exercise its discretionary power, the Petition for a Writ of Certiorari should be denied.

Respectfully submitted,

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September 7, 1950.